AMENDMENTS TO THE DRAWINGS

Figure 6 has been amended to contain the legend "Prior Art" with the heading "Replacement Sheet" and is located in the Appendix.

Remarks/Arguments

Claims 1 to 7 are pending in the subject application. Claims 1 to 7 have been amended to put them more in line with US patent practice. Support is found on page 12, lines 8 to 11, for the amendment in Claim 1 that the internal holding member which is made of a porous substance having microscopic pores that hold the liquid therein to keep the filtration film wet.

The Office Action stated: that the listing of references in the specification is not a proper information disclosure statement; that 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper"; and that, therefore, unless the references have been cited by the Examiner on form PTO-892, they have not been considered. Applicants disagree with this statement. The Examiner is required to read and consider all of the disclosure in the application, including the prior art disclosed and discussed on page 1, lines 8 and 9, and page 1, line 12, to page 2, line 18, of the application.

The Office Action stated: that the use of the trademark MILLIPORE EXPRESS has been noted in this application; and that it should be capitalized wherever it appears and be accompanied by the generic terminology. The subject trademark has been capitalized on page 11, line 24, with the generic statement that MILLIPORE EXPRESS® PLUS membrane filter is composed of polyethersulfone.

The Office Action stated: that, although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every

effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The Office Action stated: that Figure 6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated; that applicants should see MPEP § 608.02(g); that corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office Action to avoid abandonment of the application; that the replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures; that, if the changes are not accepted by the Examiner, the applicants will be notified and informed of any required corrective action in the next Office Action; and that the objection to the drawings will not be held in abeyance. A copy of Figure 6, amended to contain the legend "Prior Art" and labeled "Replacement Sheet", is enclosed in the Appendix. Withdrawal of this objection is requested.

The Office Action stated: that the following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The Office Action stated: that in lines 1 to 2, "the internal layer bag" lacks antecedent basis in Claim 1. Claim 6 has been amended to make it dependent upon Claim 5 which is believed presents antecedent basis.

Withdrawal of this objection is requested.

The Office Action stated that the following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that forms the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 5 and 7 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Published Patent Application No. 2002/0153386 (Uetake et al.). Applicants traverse this rejection.

Claim I has been amended to recite that the internal liquid holding member is made of a porous substance having microscopic pores that hold the liquid therein in order to keep the filtration film wet. The application states:

"An internal liquid holding member 25b...and the microscopic pores...are able to hold the liquid in the container." [Page 12, lines 7 to 10]

Uetake et al. does not teach, or even suggest, that its filter support 50 is made of a material having microscopic pores. In fact, Uetake et al. teaches/directs away from the use of a filter support 50 made of a substance having microscopic pores. Uetake et al, states:

"This filter 7...is supported by a seat 50.... This seat 50 is...perforated at 51 to keep minute voids in liquid communication with the cavity." [Page 4, second col., paragraph 0046, lines 7 to 11]

Figure I of Uetake et al.clearly shows that perforations 51 of filter support 50 are (visible) passageways (perforations) that pass unimpeded all of the way through filter support 50 (with an opening on both sides of filter support 50), and are not microscopic pores. Applicants' internal liquid holding member 25b (see amended independent Claim 1) is made of a porous material having microscopic pores that hold the liquid therein in order to keep the filtration film wet. This claimed feature/limitation is not taught or suggested by Uetake et al.

Even if the inner negative pressure occurs by the elastic memory of the bag 16, the member 25b maintains holding the liquid because the filter 25 is provided in a manner wherein the pressure for vacuuming the air from the lower side is higher than the difference between the inner pressure of the inner bag and the ambient pressure (see page 13, lines 1 to 9, of the specification).

The Office Action stated: that Uetake et al. teaches, in reference to Claim 1, a container with a filter (1) comprising: a bottle (2) having a mouth portion (2a); a plug body (3) placed on the mouth portion and providing a discharging pass (10) for discharging internal liquid kept in the bottle; and a filter (7, 50) provided in the discharging pass; wherein said filter (7, 50) has a filtration film (7) to filter out bacteria for preventing bacteria from percolating from downstream side to upstream side in the direction of discharging and an internal liquid holding member (50) which is made of porous substance (perforations 50[?]) and placed upstream side of the filtration film; and a surface of said internal liquid holding member is in contact with a surface of the filtration film (see Fig. 1 and [0046]). Uetake et al. has been above to not anticipate any of applicants' claims.

The Office Action stated that, in reference to Claims 4 and 7, applicants should see Fig. 1 and [0046]. The dependent claims are not anticipated because to the independent claim is not anticipated.

The Office Action stated that, in reference to Claim 5, applicants should see Fig. 1 and [0038] to [0041]. The dependent claim is not anticipated because the independent claim is not anticipated.

This rejection should be withdrawn.

Claims 1, 4, 5 and 7 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication 2002/0130139 (Shiraishi et al.). Applicants traverse this rejection.

Claim 1 has been amended to recite that the internal liquid holding member is made of a porous substance having microscopic pore that hold the liquid therein in order to keep the filtration film wet. Shiraishi et al. does not teach, or even suggest, that its filter support 50 is made of a material having microscopic pores. In fact Shiraishi et al. teaches/directs teaches/directs away from the use of a filter support made of a substance having microscopic pores. Shiraishi et al. states:

> "...filter 7 is...secured by a retainer 50....The retainer 50 has through-holes 50a through which can flow towards the filter." [Page 6, first col., paragraph 0067, lines 10 to 14]

Applicants' amended independent Claim 1 requires an internal liquid holding member 25b that is made of a porous material having microscopic pores that hold the liquid therein in order to keep the filtration film wet. This claimed feature/limitation is not taught or suggested by Shiraishi et al.

The Office Action stated: that Shiraishi et al. teaches: in reference to Claim 1, a container with a filter (1) comprising: a bottle (2) having a mouth portion (2a); a plug body (3) placed on the mouth portion and providing a discharging pass (10) for discharging internal liquid kept in the bottle; and a filter (7, 50) provided in the discharging pass; wherein said filter (7, 50) has a filtration film (7) to filter out bacteria for preventing bacteria from percolating from downstream side to upstream side in the direction of discharging and an internal liquid holding member (50) which is made of porous substance (perforations 50a) and placed upstream side of the filtration film; and a surface of said internal liquid holding member is in contact with a surface of the filtration film (see Fig. 3 and [0067]). As shown above, Shiraishi et al. does not anticipate any of applicants' claims.

The Office Action stated that, in reference to Claims 4 and 7, applicants should see Fig. 3 and [0067]. The dependent claims are not anticipated because the independent claim is not anticipated.

The Office Action stated that, in reference to Claim 5, applicants should see Figs. 1, 3 and [0056] to [0060]. The dependent claim is not anticipated is not anticipated because the independent claim is not anticipated.

This rejection should be withdrawn.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter

pertains; and that patentability should not be negatived by the manner in which the invention was made.

Claims 2 to 3 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Uetake et al. in view of Applicants' Admitted Prior Art (AAPA). Applicants traverse this rejection.

The rejection combination of Uetake et al. and the AAPA does not result in applicants' claimed invention so it is not obvious over such combination of rejection references. Uetake et al. does not disclose an internal liquid holding member that is made of a porous substance having microscopic pores. The AAPA also does not disclose an internal liquid holding member that is made of a porous substance having microscopic pores.

The Office Action stated: that, in reference to Claim 2, Uetake et al. teaches a container with filter substantially according to Claim 1, but does not teach the particular filter according to the claim; that AAPA (specification page 11, line 15 to page 12, line 6) teaches that the claimed filter is a "Millipore Express Plus membrane filter" i.e., commercially available prior art filter. This is not a teaching or a suggestion of applicants' claimed internal liquid holding member or its purpose. Uetake et al.'s support 50 is not disclosed to have microscopic pores.

The Office Action stated: that it would have been obvious to one having ordinary skill in the art to have selected the AAPA Millipore Express Plus membrane filter for use in the device of Uetake et al. since Uetake et al.suggests the use of any filter suited for preventing bacteria from entering the upstream side from the downstream side (see [0043]); that, further, the application of the AAPA filter to Uetake et al. constitutes no more than combining prior art elements according to known methods to yield

predictable results and the simple substitution of one known element for another to obtain predictable results supporting a conclusion of obviousness in accordance with the guidance of *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. __, 82 USPQ2d 1385. Applicants traverse this statement as being irrelevant since it does not concern the special internal liquid holding member in applicants' claimed invention. Also, since the Examiner has not factually resolved in the record the level of ordinary skill in the art he cannot say what would obvious to one ordinarily skilled in the art. See the KSR and Graham decisions of the Supreme Court.

The Office Action stated: that, in reference to Claim 3, when AAPA prior art filter is used with Uetake et al., (with the same liquid) the device would inherently perform in the same manner; and that, further, "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." (see MPEP 2144.05 II). This statement is not relevant because it does not deal with applicants' internal liquid holding member.

This rejection should be withdrawn.

Claim 6 has been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application 2002/0130139 (Shiraishi et al.) in view of U.S. Patent No. 5,497,910 (Meadows et al.). Applicants traverse this rejection.

The rejection combination of Shiraishi et al. and Meadows et al. does not result in applicants' claimed invention so it is not obvious over such combination of rejection references. Neither Shiraishi et al. nor Meadows et al. discloses an internal liquid holding membrane that is made of a porous substance having microscopic pores.

The Office Action stated: that, in reference to Claim 6, Shiraishi et al. teaches a container with a filter (1) as set forth in Claim 1 (see rejection of Claim 1 above); and that Shiraishi et al. further teaches: wherein a dispensing valve (8) has memory which expands said dispensing valve and generates negative pressure in the container so that a pressure difference between the negative pressure and an ambient pressure becomes higher than the filtration resistance thus liquid left downstream side of the filtration film is aspirated to up stream side of the filtration film (see [0043] and [0053]). This not a teaching or a suggestion of applicants' claimed internal liquid holding member or its purpose. Shiraishi et al.'s support 50 is not disclosed to have microscopic pores.

The Office Action stated: that Shiraishi et al. differs from the claim in that it is the resilient dispensing valve (8) and its associated connector sleeve (83) which causes the remaining liquid to be sucked into an up stream side of the filter rather than the memory of internal layer (22) which is disclosed to be made of a synthetic resin made of a resilient material (see [0057] and [0060]). This statement is incorrect – Shiraishi et al. does not disclose an internal liquid holding membrane that has microscopic pores.

The Office Action stated: that Meadows et al. teaches: in Figs. 1 to 3 of a dispenser similar to that of applicants' and Shiraishi et al. to make an inner layer (inner bottle 30) from a resilient (compressible) material (LDPE) configured so as to create a "suck back" vacuum (see col. 4, lines 57 to 62; col. 5, lines 35 to 43). This statement does not even suggest applicants' internal liquid holding membrane having microscopic pores.

The Office Action stated that it would have been obvious to one having ordinary skill in the art at the time of the invention to have applied the teaching of using the characteristics of the compressible inner bottle to suck back liquid into the inner layer of Meadows et al. in the dispenser of Shiraishi et al. because doing so would allow the suck back function to be performed without the use of a resilient valve. Even if this were so, the result is not applicants' Claim 1 (or any claim dependent thereon). The Examiner does not know what would be obvious to one ordinarily skilled in the art.

The Office Action stated: that, further, the application of the teaching of Meadows et al. to Shiraishi et al. constitutes no more than combining prior art elements according to known methods to yield predictable results and the use of a known technique to improve similar device in the same way supporting a conclusion of obviousness in accordance with the guidance of *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. __, 82 USPQ2d 1385. This statement is not relevant because it does not deal with applicants' internal liquid holding membrane.

This rejection should be withdrawn.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

June 29, 2009
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 29, 2009.

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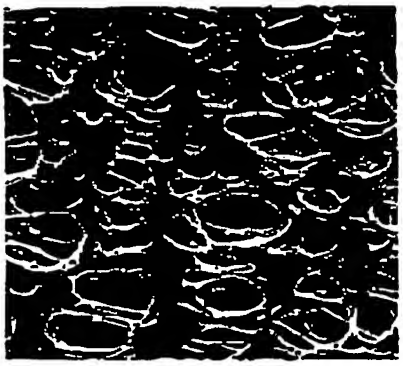
APPENDIX

MILLIPORE

Millipore Express® PLUS Membrane Filters



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- Ordering Information
- Technical Library

Polyethersulfone

The Millipore Express PLUS membrane provides ultrafast filtration of tissue culture media, additives, buffers and other aqueous solutions. This high-throughput, low-protein-binding membrane is also used in many of our ready-to-use sterile filtration devices.

Specifications (return to top)

Color: white
Surface: plain
Thickness: ≥150 µm and ≤200 µm
Sterilization: by autoclave (121 °C at 1 bar), EO or gamma
Bacterial endotoxins: 0.5 EU/mL
Gravimetric extractables: <1.5%
Flow rate: 40 mL/min cm^2 at 2 bar, 25 °C

Ordering Information (return to top)

Select up to 6 products to compare them side by side

Compare	Catalogue No.	Filter Pore Size, µm	Filter Diameter, mm	Qty/Pk	
☐	HPWP01300	0.45	13	100	» Add to Cart
☐	HPWP02500	0.45	26	100	» Add to Cart
☐	HPWP04700	0.45	47	100	» Add to Cart
☐	HPWP09050	0.45	90	50	» Add to Cart
☐	HPWP14250	0.45	142	50	» Add to Cart
☐	GPWP01300	0.22	13	100	» Add to Cart
☐	GPWP02500	0.22	25	100	» Add to Cart